MOTION FILED
APR 16 1999

(4)

No. 98-1500

In The
Supreme Court of the United States

October Term, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORP.,
Petitioners,

v.

MATTHEW BENDER & COMPANY, INC. and
HYPERLAW, INC.,
Respondents.

ON PETITION FOR WRIT OF *CERTIORARI*
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

MOTION FOR PERMISSION TO FILE *AMICUS CURIAE* OPPOSITION TO PETITION FOR *CERTIORARI* and OPPOSITION TO PETITION FOR *CERTIORARI* BY *AMICUS CURIAE* MALLA POLLACK, SUPPORTING RESPONDENTS

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14 pp

MOTION FOR PERMISSION TO FILE *AMICUS* OPPOSITION TO PETITION FOR *CERTIORARI*

Malla Pollack ("Pollack") respectfully moves this Court for permission to file the attached *Opposition to the Petition for Certiorari* in No. 98-1500, *West Publishing Co. and West Publishing Corp. v. Matthew Bender & Company, Inc. and Hyperlaw, Inc.* Pollack supports Respondents, Matthew Bender Company, Inc. and Hyperlaw, Inc. Pollack has received permission to file from Carl J. Hartman, counsel for Hyperlaw, Inc., and from Elliot Brown (Irell & Madella LLP), counsel for Matthew Bender & Company, Inc. James F. Rittinger (Satterlee Stephens Burke & Burke LLP), Counsel for Petitioners, has refused permission on the sole ground that my "request does not identify what relevant matter [my] opposition would bring to the attention of the Court." (Facsimile letter from Rittinger to Pollack of April 8, 1999 at 1).

INTEREST OF THE *AMICUS CURIAE*

Amicus curiae Pollack wishes to submit the attached *Opposition to Petition for Certiorari* solely to help protect the beleaguered public domain. *Cf.* David Lange, *Recognizing the Public Domain*, 44 (No. 4) Law & Contemp. Probs. 147, 176 (1981) (suggesting that in intellectual property cases the courts should "solicit and welcome amicus participation" or appoint *guardians ad litem* for the public domain). Pollack is an Associate Professor of Law who has authored articles on the interaction of the Intellectual Property Clause of the United States Constitution, U.S. Const., Art. I, sec. 8, cl. 8, with other constitutional provisions. *See* Malla Pollack, *The Right to*

Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment, 17 Cardozo Arts & Ent. L.J. 47 (1999); Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of* Shakespeare Co. v. Silstar Corp., 18 Seattle U. L. Rev. 259 (1995).

ARGUMENT
REASONS TO GRANT PERMISSION

Pollack respectfully submits that the attached brief "brings to the attention of the Court relevant material" that is not likely to be addressed fully by the parties. Sup. Ct. R. 37.1.

Petitioners raise only statutory issues. Pollack wishes to alert this Court to the constitutional dimensions of this case.

Petitioners argue the economic importance of the Court's helping business persons in Petitioners' industry. Pollack wishes to alert this Court to Congress' already on-going investigation of Petitioners' economic assertions.

Petitioners and Respondents are all businesses that wish to earn revenue from legal publishing. Pollack volunteers to act as unpaid spokesperson for the general public's interest in its public domain.

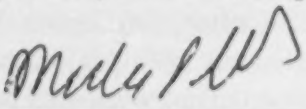
Pollack respectfully claims some slight expertise as she has just published an article concerning the issues not discussed in West Publishing Co. and West Publishing

Corp.'s Petition for Certiorari. *See* Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 Cardozo Arts & Ent. L.J. 47 (1999).

CONCLUSION

For all the reasons discussed above, Pollack respectfully requests this Court to allow her to file the attached *pro se Opposition to Petition for Certiorari by Amicus Curiae Malla Pollack*, supporting Respondents.

Respectfully submitted April 16, 1999



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OPPOSITION TO PETITION FOR CERTIORARI

INTEREST OF THE *AMICUS CURIAE*

Amicus curiae Malla Pollack ("Pollack")[1] submits this brief solely to help protect the beleaguered public domain. *Cf.* David Lange, *Recognizing the Public Domain*, 44 (No. 4) Law & Contemp. Probs. 147, 176 (1981) (suggesting that in intellectual property cases the courts should "solicit and welcome amicus participation" or appoint *guardians ad litem* for the public domain). Pollack is an Associate Professor of Law who has authored articles on the interaction of the Intellectual Property Clause of the United States Constitution, U.S. Const., Art. I, sec. 8, cl. 8, with other constitutional provisions. *See* Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 Cardozo Arts & Ent. L.J. 47 (1999) (hereinafter "*Right to Know*"); Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of* Shakespeare Co. v. Silstar Corp., 18 Seattle U. L. Rev. 259 (1995).

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1 No part of this brief was authored in whole or in part by counsel for any party. Malla Pollack is paying the cost of preparation, printing, and submission of her *amicus* filings personally and from the Professional Development Fund provided by her employer, Florida Coastal School of Law, 7555 Beach Blvd., Jacksonville, FL 32216.

SUMMARY OF ARGUMENT

The Court should deny the petitions for *certiorari* filed by West Publishing Co. and West Publishing Corp. ("the Petitioners") in both No. 98-1500 and No. 98-1519 (collectively "West's Cases").[2] Petitioners raise only issues under the Copyright Act, 17 U.S.C. §§ 101 *et. seq.*, as construed by *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). The central issues in both of West's Cases, however, are the interrelationships among the Intellectual Property Clause, U.S. Const. art. I, § 8, cl. 8, the Commerce Clause, U.S. Const. art. I, § 8, cl. 3, and the First Amendment, U.S. Const. amend. I. Petitioners have not, however, posed these constitutional questions in their petitions for *certiorari*. Any Supreme Court opinion in this case, no matter how narrowly drafted, would risk generating further confusion on constitutional matters.

Congress, furthermore, is currently considering both Petitioners' market concerns and the constitutional issues related to Commerce Clause protection of writings. Judicial economy and inter-branch comity counsel waiting for Congress to finish. At the minimum, Congress will clarify the factual background. At the maximum, Congress will render the legal issues obsolete.

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2 Pollack has filed substantively identical *amicus* papers in both cases.

ARGUMENT

A. *Certiorari* Is Inappropriate Because This Case Does Not Proffer For Decision The Central Constitutional Issues Involved

West Publishing Co. and West Publishing Corp. ("Petitioners") pose only questions regarding the Copyright Act, 17 U.S.C. §§ 101 *et. seq.*, as construed since *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). *See* West Publishing Co. and West Publishing Corp.'s Petition for Certiorari at i (Questions Presented). *Feist*, however, targeted the constitutional limits imposed upon the Copyright Act by the Intellectual Property Clause of the United States Constitution. U.S. Const. art. I, § 8, cl. 8 ("Congress shall have the power . . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."). *See, e.g., Feist*, 499 U.S. at 344 ("Originality is a constitutional requirement"); *id.* at 351 ("As we have explained, originality is a constitutionally mandated prerequisite for copyright protection."); *id.* at 363 ("As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimus* quantum of creativity.").

Feist dropped conflicting hints about additional Commerce Clause protection for sweat works (such as the parties' publications).

Additional protection might be supported by *Feist*'s dictum that:

> [p]rotection for the fruits of such [factual] research . . . may in certain circumstances be available under a theory of unfair competition. [Even though] to accord copyright protection on this basis alone distorts basic copyright principles . . . .

Id. at 354. This dictum, however, may be read differently. "[U]nfair competition," *Feist*, 499 U.S. at 354 (O'Connor, J.), is rooted in the "common law of deceit" and concerned only with "protecting consumers from confusion." *See Bonito Boats v. Thundercraft Boats*, 489 U.S. 141, 157 (1989) (O'Connor, J.).

Feist, furthermore, undercuts additional protection by pronouncing that misappropriation, the basis of the Court's decision in *International News Serv. v. Associated Press*, 248 U.S. 215 (1918), is "not relevant" to massive copying from a sweat work. *Feist*, 499 U.S. at 354 n.(unnumbered). *See The Right to Know*, *surpa*, 17 Cardozo Arts & Ent. L.J. at 76-77.

After *Feist*, the important disputed territory lies at the intersection between the Intellectual Property Clause and the Commerce Clause. The Court has never mapped this intersection, but the Court has fenced the similar junction between the Commerce Clause, U.S. Const. art. I, § 8, cl. 3, and the Bankruptcy Clause, U.S. Const. art. I, § 8, cl. 4. ("The Congress shall have power . . . To establish . . . uniform Laws on the subject of Bankruptcies throughout the United States."). The Court restrained Congress from using the Commerce Clause to circumvent the Bankruptcy Clause's uniformity requirement. *See Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 471 (1982) (statute intended to help one specific bankrupt railroad is beyond Congress'

power). *Railway Labor* suggests that the Commerce Clause may not be used to bypass textual limits in the Intellectual Property Clause. Commentators, however, differ on the borders of *Railway Labor*. *Compare, e.g., Right to Know, supra*, 17 Cardozo Arts & Ent. L.J. at 61 (after *Railway Labor* and *Feist*, a sweat work "protection act grounded on the Commerce Clause can pass constitutional scrutiny only if the act is carefully limited to situations of market failure.") *with* Jane Ginsberg, *No "Sweat"? Copyright and Other Protection of Works of Information After* Feist v. Rural Telephone, 92 Colum. L. Rev. 338, 370-71 (1992)(After *Railway Labor* and *Feist*, "Congress might have power to enact a misappropriation statute under the Commerce Clause if the statute set forth a scheme of protection quantitatively different from a copyright regime.")

The junction between the Intellectual Property and Commerce Clauses is both sufficiently important and sufficiently dark to warrant Supreme Court illumination in an appropriate case. This, however, is not an appropriate case. Petitioners have not posed constitutional questions.

Because the competing books and CD-ROM products at issue transmit legal opinions to the public, West's Cases carry judicial scrutiny toward an additional constitutional intersection — the crossroads between the Intellectual Property Clause and the First Amendment (Speech, Press, and Petition Clauses). This constitutional junction is also both important and largely unmapped.

Re importance, as James Madison famously pronounced "[k]nowledge will forever govern ignorance" and "[a] popular government without popular information [] or the means of acquiring it is but a prologue to a farce or a

tragedy or perhaps both." Letter from James Madison to W.T. Berry (Aug. 4, 1822), *in* James Madison, *The Complete Madison* 337 (Saul K. Padover ed., 1953).

Re uncertain topography, the First Amendment/Intellectual Property Clause interchange is largely unilluminated. True, this Court pronounced that

> copyright's idea/expression dichotomy strikes a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.

Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 556 (1985). Since the copier in *Harper & Row* lost, however, *id.* at 542, the quoted statement is merely dictum. This Court has never held an intellectual property right unconstitutional on the ground that the First Amendment requires the idea/expression dichotomy. *See Right to Know*, *supra*, 17 Cardozo Arts & Ent. L.J. at 68-69 nn.106-12. The text of the Constitution, furthermore, does not announce a right to know.

Again, the constitutional area is worth this Court's exploration in an appropriate case. Again, this is not an appropriate case. Petitioners have not posed constitutional questions.

If the Court grants *certiorari* to the Petitioners, the Court unnecessarily[3] risks compounding constitutional

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3 As discussed *infra*, Section II, Petitioners have nonjudicial recourse. Congress is considering whether producers of sweat works need increased legal protection. Petitioners

confusion. Petitioners' and Respondents' works are the type of sweat works addressed in *Feist*. Any opinion by this Court, therefore, will be scrutinized for its clarification of the constitutional issues raised, but not resolved, in *Feist*. The Court, however, cannot use Petitioners' cases to properly address these important constitutional issues for the simple reason that Petitioners have not asked the right questions — at trial, on appeal, or in their petitions for *certiorari*.

B. *Certiorari* Is Inappropriate Because Congress Is Already Considering The Economic And Constitutional Issues Central To This Case

Petitioners rely on the alleged economic importance of this case. Petitioners argue that numerous, publicly beneficial sweat works will not be created or marketed absent Court action. *See, e.g.*, West Publishing Co. and West Publishing Corp.'s Petition for Writ of Certiorari at 4, 10, & 15-16. Petitioners should (and already have) addressed their economic arguments to Congress.

Congress is considering whether database protection legislation is warranted to close the alleged "protection gap" created by *Feist*. *See, e.g., Hearings on H.R. 354, "Collections of Information Anti-piracy Act" before the House Judiciary Subcommittee on Courts and Intellectual Property*, 106th Cong. 2 (March 18, 1999)(hereinafter "March 1999 Hearings")(statement of Marybeth Peters, Register of Copyrights) (*Feist* motivated consideration of a database protection statute) <http:// www.house.gov/ judiciary/ 106-pete.htm> (visited March 18, 1999); 145 Cong. Rec. S316 (daily ed. Jan. 19, 1999)(remarks of

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have submitted testimony to Congress. *See infra* at 8-9.

Senator Orrin Hatch)(same); *see also Right to Know, supra*, 17 Cardozo Arts & Ent. L.J. 58 n.62 (collecting references to *Feist* as Congress' motivation for considering database legislation).

Congress has already invested substantial resources in collecting relevant information and opinions. The 104th Congress considered The Database Investment and Intellectual Property Antipiracy Act, H.R. 3531. *See* 143 Cong. Rec. E890-91 (daily ed. May 23, 1996)(introductory statement by Hon. Carlos J. Moorehead). The House of Representatives, 105th Congress, passed two slightly different versions of The Collections of Information Anti-piracy Act. *See* H.R. 2652 (passed May 19, 1998), 144 Cong. Rec. H73398-404 (daily ed. May 19, 1998); H.R. 2652 (passed Aug. 4, 1998), 144 Cong. Rec. H7074-104 (daily ed. Aug. 4, 1998). The Senate, 105th Congress, considered, but did not vote on, a companion bill, S. 2291. *See* 144 Cong. Rec. 7959 (daily ed. July 10, 1998)(bill read twice and referred to the Committee on the Judiciary). Three different database bills have already been suggested to the Senate, 106th Congress. *See* 145 Cong. Rec. S316-26 (daily ed. Jan, 19, 1999)(remarks of Senator Orrin Hatch). The House, 106th Congress, has already held hearings on H.R. 354, The [revised] Collections of Information Anti-piracy Act. <http:// www.house.gov/ judiciary/ 031799.htm> (visited March 18, 1999) (written testimony from March 18, 1999 hearings before House Judiciary Subcomm. on Courts and Intellectual Property).

Petitioners have offered testimony on the currently pending H.R. 354 through two witnesses. *See* March 1999 Hearings, *supra*, (statement of Ms. Marilyn Winokur on behalf of the *ad hoc* Coalition Against Database Piracy,

which includes West's owner, The Thompson Corp., at 4); *id.* (statement of Daniel C. Duncan on behalf of the Software Information Industry Ass'n, which includes West's owner, The Thompson Corp., at 3).

Despite Petitioners' plaint, the economic case for additional protection is not clear. Even the economic expert hired by a pro-protection industry group went no farther than urging Congress to "consider how fast the industry might have grown with statutory protection;" but as she admitted "[t]he database industry has grown rapidly, driven by new technologies. Since 1979, the number of databases on the market has grown nearly 10-fold." *Hearings on the "Collections of Information Antipiracy Act" Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 105th Cong. 2 (Oct. 1997) (statement of Laura D'Andrea Tyson and Edward F. Sherry, paid consultants for the Information Industry Ass'n). In the aftermath of *Feist*, between 1991 and 1997, (i) the number of databases increased from 7637 to 10338, i.e. 35%, and (ii) the number of files in databases increased from 4 billion to 11.2 billion, i.e. 180%. *See Hearings on the "Collections of Information Antipiracy Act" Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 105th Cong. 4 (Feb. 1998) (statement of Jonathan Band, Online Banking Ass'n, opposing legislation).

Economists are split on whether the absence of legal protection for intellectual property would generate under-production or over-production of information products, such as Petitioners'. *See* James Boyle, *A Politics of Intellectual Property: Environmentalism for the Net?*, 47 Duke L.J. 87, 98 (1997)(collecting economic authorities).

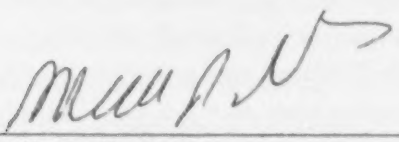
Judicial economy counsels waiting for Congress to finish studying the complexities of information markets. At the minimum, Congress will clarify the factual background. At the maximum, Congress will render the legal issues obsolete.

Judicial comity with a co-equal branch of government also counsels this Court to wait for Congress' views on the constitutional issues before revisiting *Feist*. *See, e.g.*, Ruth Bader Ginsberg, *Speaking In A Judicial Voice*, 67 N.Y.U. L. Rev. 1185, 1198 (1992)(Judges "participate in a dialog with other organs of government, and with the people as well"; "[m]easured motions seem to me right, in the main, for constitutional as well as comon law adjudication. Doctrinal limbs too swiftly shaped, experience teaches, may prove unstable.")(footnotes omitted). Congress is aware of the constitutional dimensions of granting protection to sweat works. *See, e.g.*, March 1999 Hearings ("the Administration's concerns . . . include the concern that the Constitution imposes significant constraints upon Congress' power to enact legislation of this sort.")(statement of Andrew J. Pincus, U.S. Dep't of Commerce, at 3). The congressional inquiry, furthermore, may trigger learned discussion of the constitutional issues; such discussion may ease this Court's path through a later presented and more appropriate case.

CONCLUSION

For all the reasons discussed above, this Court should deny Petitioners' request for *certiorari*.

Respectfully submitted April 16, 1999



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